REMARKS

The Final Office Action mailed April 29, 2008, has been received and reviewed. Each of claims 1–38 stands rejected. No claims have been added or amended. Accordingly, claims 1–38 remain pending. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

The Finality of the Office Action is premature

MPEP § 706.07(a) recites:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (emphasis added)

In the present case, the finality of the Office Action mailed April 29, 2008, is premature because the new ground of rejection was not necessitated by Applicants' claim amendment nor supported by a reference disclosed on an IDS submitted during the period set forth in 37 C.F.R. 1.97(c). The Examiner introduced a new ground of rejection in the present Office Action by switching from a 35 § U.S.C. 103(a) rejection based on the DeBusk reference and the Zimmerman reference to a 35 § U.S.C. 102(b) rejection based solely on the DeBusk reference. This new ground of rejection was not necessitated by Applicants' amendments. In Applicants' last response, Applicants successfully argued that the Zimmerman reference was disqualified under 35 § U.S.C. 103(c). No claim amendments were made. Because none of the claims were amended, the new ground of rejection could **not** have been **necessitated** by Applicants' amendment. Additionally, Applicants did not submit an IDS during the period set

forth in 37 C.F.R. 1.97(c). Accordingly, Applicants request withdrawal of the finality of the present Office Action.

Rejections based on 35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP § 2131.

Claims 1-38 are rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent Number 5,682,728 to DeBusk et al. (hereinafter "DeBusk reference") As the DeBusk reference fails to describe, either expressly or inherently, each and every element of claims 1-38, Applicants respectfully traverse the rejection, as hereinafter set forth.

Independent claim 1, recites a system for automatically fulfilling orders for clinical supplies. The system includes an interface to a supply chain engine, the supply chain engine automatically generating at least one order for clinically related supplies based upon supply consumption data derived from documentation of at least one clinical event reported from at least one clinically related site, the supply consumption data including items used and/or consumed during the at least one clinical event. The system also includes a fulfillment engine, communicating with the interface to the supply chain engine, the fulfillment engine triggering delivery of clinically related supplies based at least upon the order for clinically related supplies.

The DeBusk reference, on the other hand, describes the management of consumable medical supplies by creating bills of material associated with care events within a

clinical pathway. *See DeBusk reference* at col. 2, l. 29-37. A bill of materials representing those medical supplies "to be used" for a scheduled care event is generated and those supplies are placed into supply bundles at a number of locations and then delivered in bundled form to the end-user. *See id.* at col. 2, l. 50 to col. 3, l. 2; and col. 3, l. 34. The DeBusk reference also discloses anticipating supply usage based upon historical records relating to the frequency of occurrence of given care events at a particular facility and/or aggregated facility usage of common medical supplies over time. *See id.* at col. 2, l. 59 to col. 6, l.13.

It is respectfully submitted that the DeBusk reference fails to describe, either expressly or inherently, supply consumption data derived from documentation of at least one clinical event or supply consumption data including items used and/or consumed during a clinical event. The DeBusk reference describes the management and procurement of supply bundles containing medical supplies "intended for use" in a future care event. *See,* DeBusk reference at col. 5, l. 22-45. As will be appreciated by one of ordinary skill in the art, upon occurrence of the future care event, some of the items included in the supply bundle may not be used at all. As such, the supplies "intended for use" and the supplies actually used or consumed during an event cannot be equated. The supply procurement method described in the DeBusk reference orders supplies based on anticipated use. Claim 1 records the use of supplies in clinical events and generates orders to replenish used supplies. Thus, the DeBusk reference does not describe an identical invention with as complete detail as is contained in claim 1.

As the DeBusk reference fails to describe each and every element of independent claim 1, Applicants respectfully submit that claim 1 is not anticipated by the DeBusk reference. Each of claims 2–14 depends, either directly or indirectly, from independent claim 1 and defines further patentable features. For example, claim 4 recites a system according to claim 1, wherein

the supply chain generates the at least one clinical supply order based upon at least one clinical quantity threshold. In contrast, the DeBusk reference describes stocking units of supplies based on calculable demands. *See* DeBusk reference at col. 3, ll. 45-50. The DeBusk reference does not describe generating an order at a particular inventory threshold. Accordingly, it is respectfully submitted that the DeBusk reference does not anticipate claims 2-14 for at least the above-cited reasons. As such, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1-14 is requested.

Independent claim 15, recites a method for automatically fulfilling orders for clinically related supplies. The method includes automatically generating at least one order for clinically related supplies based upon supply consumption data derived from documentation of at least one clinical event from at least one clinically related site, the supply consumption data including items used and/or consumed during the at least one clinical event. The method also includes triggering delivery of clinically related supplies based at least upon the at least one order for clinically related supplies.

For reasons substantially similar to those given with reference to claim 1, the DeBusk reference fails to describe, either expressly or inherently, supply consumption data derived from documentation of at least one clinical event or supply consumption data including items used and/or consumed during a clinical event. Thus, Applicants respectfully submit that the DeBusk reference fails to describe each and every element of independent claim 15. Therefore, the DeBusk reference does not anticipate claim 15. Each of claims 16-26 depends, either directly or indirectly, from independent claim 15. Accordingly, it is respectfully submitted that the DeBusk reference does not anticipate claims 16-26 at least by virtue of their dependency

from allowable claim 15. As such, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 15-26 is requested.

Independent claim 27, recites a set of clinically related supplies generated for delivery. The set of clinically related supplies recited in claim 27 is generated by a method including automatically generating at least one order for clinically related supplies based upon supply consumption data derived from documentation of at least one clinical event from at least one clinically related site, the supply consumption data including items used and/or consumed during the at least one clinical event. The method also includes triggering delivery of clinically related supplies based at least upon the at least one order for clinically related supplies.

For reasons substantially similar to those given with reference to claim 1, the DeBusk reference fails to describe, either expressly or inherently, supply consumption data derived from documentation of a clinical event or supply consumption data including items used and/or consumed during a clinical event. Thus, Applicants respectfully submit that the DeBusk reference fails describe each and every element of independent claim 27. Therefore, the DeBusk reference does not anticipate claim 27. Each of claims 28-38 depends, either directly or indirectly, from independent claim 27. Accordingly, it is respectfully submitted that the DeBusk reference does not anticipate claims 28-38 at least by virtue of their dependency from allowable claim 27. As such, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 27-38 is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-38 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or johoward@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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